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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/755,856

01/12/2004

Maurice Gell

UCT-0040

8424

23413 7590 06/09/2008
CANTOR COLBURN, LLP
20 Church Street
22nd Floor
Hartford, CT 06103

EXAMINER

SAVAGE, JASON L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/755,856	Applicant(s) GELL ET AL.	
	Examiner JASON L. SAVAGE	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23, 25-38, 40, 43-63, 65 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 32, 53-62 and 65-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-21, 23, 25-31, 33-38, 40, 43-52 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/08 has been entered.

Claim Rejections - 35 USC § 112

Claims 16-21, 23, 25-31, 37, 40, 43-48, 63 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the use of metal oxides, metal carbides, metal nitrides, metal silicides and combinations of one or more of the foregoing within the produced material such as described in paragraph [0042] of the specification, does not reasonably provide enablement for any and all types of materials. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims without undue experimentation.

A number of factors must be considered in assessing the enablement of an invention, including the following: the breadth of the claims, the amount of experimentation necessary, the guidance provided in the specification, working examples provided, predictability, and the state of the art. See *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Circ. 1988).

The specification describes use of metal oxides, metal carbides, metal nitrides, metal silicides and combinations of one or more of the foregoing including a variety of specific compounding materials within the produced material. However, the claims are of such breadth that they widely encompass the incorporation of any unspecified material, and do not provide sufficient guidance toward the use of any particular material. Thus, it would require one skilled in the art an undue amount of experimentation to test any random material encompassed by the claims, in an attempt to make and use the claimed invention. Furthermore, regarding claims 33-36, 38 and 49-52, it is noted that these claims state that the "material comprises" these recited compounds; however, it does not state that this material is part of (a) the splat, (b) the interpass boundary, (c) both, or (d) some other unnamed portion of the claimed "material", due to the term "comprises". In other words, for example looking at claims 16 & 33, it cannot be determined if one of the recited metal compounds make up (some percentage of) the splat material, or the interpass boundary, or both, or neither. Similarly with claim 35, it is unclear what portion is made of ceramic. Thus, furthermore it is unclear if the entire claimed "material" is made of either a metal or ceramic compound, or if this simply refers to one individual portion only, etc. If the latter, then it is unclear as to which one is which. Given this lack of specific guidance and teaching, along with the undue breadth of the claims, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims without undue experimentation.

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Response to Arguments

Applicant's arguments with respect to the claim have been considered and have overcome the prior objections and rejections but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON L. SAVAGE whose telephone number is (571)272-1542. The examiner can normally be reached on M-F 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Savage/
6-5-08

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794